

ESTTA Tracking number: **ESTTA557937**

Filing date: **09/05/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056574
Party	Defendant EI Group, LLC
Correspondence Address	JAMES C DUDA BULKEY RICHARDSON & GELINAS LLP 1500 MAIN STREET, SUITE 2700, PO BOX 15507 SPRINGFIELD, MA 01115-5060 UNITED STATES jduda@bulkley.com, tm@bulkley.com, rfederici@bulkley.com
Submission	Opposition/Response to Motion
Filer's Name	James C. Duda
Filer's e-mail	jduda@bulkley.com, cvincent@bulkley.com
Signature	/James C. Duda/
Date	09/05/2013
Attachments	Registrant's Response to Petitioner's Motion to Extend Discovery Period and Trial Dates.pdf(2677836 bytes )

In re Registration of	EL GROUP, LLC d/b/a Lotuff & Clegg
Registration No.	: 3,872,561
Registration Date	: November 9, 2010
Mark	: LOTUFF & CLEGG
Cancellation No.	: 92056574

	)	
FRANK CLEGG LEATHERWORKS, LLC,	)	
Petitioner,	)	REGISTRANT’S RESPONSE
	)	TO
v.	)	PETITIONER’S MOTION TO
	)	EXTEND DISCOVERY PERIOD AND
EL GROUP, LLC d/b/a LOTUFF & CLEGG,	)	TRIAL DATES
Registrant.	)	
	)	

After initiating a frivolous cancellation proceeding and then participating in two brief discussions with Registrant, Frank Clegg Leatherworks LLC (“Petitioner”) failed to conduct any discovery or do anything else whatsoever in this matter for more than five months. It now asks this Court to extend discovery an additional three months and force Registrant to incur additional costs *solely* because Petitioner substituted counsel five days before the close of discovery. Because Petitioner has failed to show good cause for its negligence and lack of diligence in pursuing discovery in this matter, the Board must deny its request.

## FACTS

Petitioner initiated this cancellation proceeding approximately eight months ago, on December 12, 2012. After Registrant El Group, LLC timely submitted its Answer, the parties' attorneys conducted their mandatory discovery conference on February 28, 2013. *See* Exh. A, Affidavit of James C. Duda, ¶2. Shortly thereafter, on March 13, 2013, Registrant's counsel had a telephone discussion with then counsel for Frank Clegg Leatherworks, LLC ("Petitioner"), during which Registrant's counsel proposed certain terms to resolve this matter. *Id.* ¶3. Petitioner's counsel stated at that time that he would discuss this proposal with Petitioner. *Id.* ¶4. Registrant subsequently received a copy of Petitioner's Initial Disclosers on March 29, 2013, but no response to its settlement proposal. Petitioner's counsel at that time was Blank, Rome LLP, *see Id.* ¶5, a well-recognized international law firm with a more than competent trademark litigation practice, *see, e.g.*, Blank, Rome LLP, IP Litigation Practice, available at <http://www.blankrome.com/index.cfm?contentID=13&itemID=56> (last viewed, Sept. 4, 2013).

Thereafter, until receipt of a copy of Petitioner's Substitution of Counsel dated August 19, 2013, there was no communication whatsoever from Petitioner to Registrant, regarding settlement or any other matter. That is, contrary to Petitioner's assertion within its Motion, there were no settlement discussions between the parties during the more than five month period of March 13, 2013 to the date of submission of Petitioner's Motion to Extend Discovery Period and Trial Dates. By electronic correspondence dated August 21, 2013, Registrant declined Petitioner's request to extend discover because of the attendant additional costs and the lack of any effort by Petitioner to conduct discovery during the preceding five months, and

also because of concern about the failure of Petitioner to provide a good faith response to Registrant's settlement proposal presented more than five months earlier. *See* Exh. B (email from J. Duda to M. Salvatore (Aug. 21, 2013) (details of settlement proposal redacted)).

On August 26, 2013, two days after the close of discovery, Registrant received from Petitioner a Set of Requests for the Production of Documents and Things and a Set of Requests for Admission, which Petitioner certified was mailed on August 21, 2013.<sup>1</sup> A copy of these is included as Exhibit C. As can be seen, Petitioner's document requests, totaling 33 in number, are quite extensive. Also on August 26, 2013, Registrant served discovery requests upon Petitioner. Subsequently, notwithstanding that Petitioner had just filed its Motion for Extension of Time to the Board, its counsel informed Registrant's counsel that Petitioner would refuse to respond to Petitioner's discovery. *See* Exh. D, email from S. Weinberg to J. Duda (Aug. 26, 2013)).<sup>2</sup>

## ARGUMENT

The standard for allowing an extension of time to conduct discovery in matters before this Board is "good cause." *See* Fed. R. Civ. P. 6(b)(1); TBMP § 509.01 (3<sup>rd</sup> ed. rev. 2011). The party filing a motion to extend discovery has the burden of establishing good cause and persuading the Board "that it has been diligent in meeting its responsibilities" under the rules

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<sup>1</sup> Regardless of the date mailed, the requests were timely because the day for close of discovery, August 24, 2013, fell on a Saturday so that the deadline for serving discovery was, by rule, extended to August 26, 2013. *See* 37 C.F.R. § 2.196; TBMP § 112.

<sup>2</sup> Petitioner further accused Registrant's counsel of acting in bad faith by serving discovery. *See* Exh. D. Among other things, Petitioner's counsel apparently was not familiar with the rules regarding the deadline for filing discovery when the close of discovery has been set for a Saturday, as it had been in this case. *See supra*, note 1; 37 C.F.R. § 2.196; TBMP § 112; *Nat'l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 n.6 (TTAB 2008).

and orders of the Board. See *Nat'l Football League v. DNH Management LLC*, , 85 USPQ2d 1852, 1854 (TTAB 2008). "A motion to extend must state with particularity the grounds therefor, including detailed facts constituting good cause." *Leumme, Inc.*, 53 USPQ2D 1758, 1760 (TTAB 1999) (citing Fed. R. Civ. P.6(b); Trademark Rule 2.127(a); 4A Charles A. Wright and Arthur R. Miller, *Federal Practice and Procedure*, Section 1165 (1987); HKG Industries, Inc. v. Perma-Pipe, Inc., 49 USPQ2d 1156, 1158 (TTAB 1998). The Board "'will scrutinize carefully any such motions' in determining whether good cause has been shown, including the diligence of the moving party during the discovery period." *Leumme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999), (quoting "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 63 Fed. Reg. at 48086, 1214 TMOG at 149). As the Board has pointed out, "[it] should not have to remind petitioner that it brought this cancellation proceeding in the first instance, and that it carries the burden of going forward in a timely manner." *Leumme*, 53 USPQ2d at 1761.

Petitioner clearly has not met its burden. There is no evidence in the record to show that Petitioner has been diligent during the discovery period, and it has failed to identify any facts, detailed or otherwise, that would constitute good cause for that lack of diligence. Contrary to the assertion of counsel in its Motion, Petitioner's lack of diligence is not explained by ongoing settlement discussions, of which there were none following Registrant's proposal more than five months ago. Nor is there evidence of counsel consumed by other litigation, or by anything else, preventing Petitioner from conducting any discovery in this matter since March.

The *only* basis that Petitioner provides for its request for an extension is that, less than one week before the close of discovery, it decided to replace its counsel. Petitioner presents no

legal, factual, or equitable support for its implicit suggestion that it should be allowed to evade its responsibilities and further run up the costs of this litigation simply by switching counsel at the last moment. "[I]t is settled that mere delay in initiating discovery does not constitute good cause for an extension of the discovery period." *Leumme*, 53 USPQ2d at 1761 (citing *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987)). As the Board has made clear, when a party waits until the last days of discovery to serve written discovery requests and does not attempt to conduct depositions during the discovery period, "a motion to extend discovery will ordinarily be denied." *Nat'l Football League*, 85 USPQ2d at 1854. Simply switching counsel before the discovery period expires, as Petitioner has done in this matter, does not turn utter lack of diligence into good cause.

### CONCLUSION

For the foregoing reasons, Petitioner's Motion to Extend Discovery Period and Trial Dates must be denied, with costs and fees awarded to the Registrant.

Respectfully Submitted,  
EL GROUP, LLC

Dated: September 5, 2013

By /James C. Duda/  
James C. Duda, Esq.  
BULKLEY, RICHARDSON AND GELINAS, LLP  
1500 Main Street, Suite 2700  
Springfield, MA 01115  
Tel.: (413) 781-2820  
Fax: (413) 272-6806  
Email: jduda@bulkley.com

CERTIFICATION OF SERVICE

I hereby certify that a copy of the foregoing was served, by First Class mail, on the 5<sup>th</sup> day of September, 2013.

/James C. Duda/

James C. Duda

# EXHIBIT A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration of : EL GROUP, LLC d/b/a Lotuff & Clegg  
Registration No. : 3,872,561  
Registration Date : November 9, 2010  
Mark : LOTUFF & CLEGG  
Cancellation No. : 92056574

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FRANK CLEGG LEATHERWORKS, LLC,  
Petitioner,  
  
v.  
  
EL GROUP, LLC d/b/a LOTUFF & CLEGG,  
Registrant.

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**AFFIDAVIT  
OF  
JAMES C. DUDA**

James C. Duda, being duly sworn, deposes and says:

1. I am a partner in the firm of Bulkley, Richardson and Gelinas, LLP, attorneys for El Group, LLC ("Registrant"). I submit this affidavit in support of Registrant's Response To Petitioner's Motion To Extend Discovery Period And Trial Dates.
2. On February 28, 2013, I had initial discussions by way of telephone with then counsel for Frank Clegg Leatherworks, LLC ("Petitioner") in connection with the parties' mandatory discovery conference.
3. On March 13, 2013, during the only other discussion I had with Petitioner's counsel prior to Petitioner's substitution of that counsel, I proposed certain terms on behalf of Registrant for resolution of this matter.

4. Petitioner's counsel stated at that time that he would discuss this proposal with Petitioner.

5. Petitioner's counsel at that time was Blank, Rome LLP.

6. I subsequently received a copy of Petitioner's Initial Disclosers on March 29, 2013.

7. Until receipt of a copy of Petitioner's Substitution of Counsel, served on August 19, 2013, neither I, nor to the best of my knowledge any other person affiliated with Registrant, received any communication from counsel or any other person associated with Petitioner after March 29, 2013.

8. To the best of my knowledge, there were no settlement discussions between the parties during the more than five month period of March 13, 2013 to the date of submission of Petitioner's Motion to Extend Discovery Period and Trial Dates.

Sworn to under the penalties of perjury this 5<sup>th</sup> day of September, 2013.

/James C. Duda/  
James C. Duda

# EXHIBIT B

**From:** Duda, James

**Sent:** Wednesday, August 21, 2013 10:12 AM

**To:** 'Michael J Salvatore'

**Subject:** RE: Cancellation No. 92056574 / Frank Clegg v. El Group, LLC /Request to Extend Discovery

Dear Mike,

My clients believe that too many resources have already been expended on this matter, they are frustrated with its progression, and they would like to bring it to a resolution at the earliest possible date. In light of (1) the little chance that extending discovery would lead to the production of additional evidence that would substantially impact the resolution of this matter; (2) the significant costs that the parties likely would incur as a result of any extension; and (3) the more than ample time that has been available for discovery during the past eight months, we see no value to extending the discovery period at this time.

Please note that we also remain concerned by the absence of a good faith response to our offer in February to resolve this matter efficiently through

**REDACTED**

Please call me if you would like to discuss any aspect of this matter.

Thank you.

Jim

**James C. Duda, Partner**

Bulkley, Richardson and Gelinas, LLP

1500 Main Street, Suite 2700 | P.O. Box 15507 | Springfield, MA 01115-5507

Direct: 413-272-6284 | Fax: 413-272-6806

[jduda@bulkley.com](mailto:jduda@bulkley.com) | [www.bulkley.com](http://www.bulkley.com)

**From:** Michael J Salvatore [<mailto:MSalvatore@holmesweinberg.com>]

**Sent:** Monday, August 19, 2013 3:55 PM

**To:** Duda, James

**Cc:** Steven M. Weinberg; Nelda Piper

**Subject:** Cancellation No. 92056574 / Frank Clegg v. El Group, LLC / Substitution of Attorney

Dear James:

Our firm has just substituted into the above-referenced cancellation proceeding. The attached is being sent to you today via US Mail. We are writing to request a 4-month extension of all pending dates, since no discovery has yet been conducted in this proceeding.

Please let us know if you will agree to the 4-month extension by close of business tomorrow, August 20, 2013.

Thank you very much,

Mike

Michael J. Salvatore

**Holmes Weinberg, PC**

30765 Pacific Coast Highway, Ste. 411 | Malibu CA 90265

t: 310.457.6100 x 201 | c. 914.263.1001 | f: 310.457.9555

[msalvatore@holmesweinberg.com](mailto:msalvatore@holmesweinberg.com) | [www.holmesweinberg.com](http://www.holmesweinberg.com) | [Bio](#)

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# EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Reg. No. 3872561

Frank Clegg Leatherworks LLC,

Petitioner,

v.

El Group, LLC,

Respondent.

Cancellation No. 92056574

**PETITIONER'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS  
AND THINGS TO RESPONDENT EL GROUP, LLC**

PETITIONER FRANK CLEGG LEATHERWORKS LLC ("PETITIONER") propounds the following PETITIONER'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS TO RESPONDENT EL GROUP, LLC and requests that, pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure, and Rule 2.120 of the Trademark Rules of Practice (37 C.F.R. §2.1.20) all documents and things responsive to these Requests be produced at the offices of PETITIONER's counsel, Steven M. Weinberg, Holmes Weinberg, PC, 30765 Pacific Coast Highway, Suite 411, Malibu, California 90265, within thirty (30) days from the service hereof.

**DEFINITIONS AND INSTRUCTIONS**

A. "RESPONDENT" and "YOU" shall refer to EL GROUP, LLC, its corporate parents, subsidiaries and affiliates, if any; and their officers, directors, employees, attorneys, agents, and other representatives.

B. "PETITIONER" or "FRANK CLEGG" shall refer to PETITIONER FRANK CLEGG LEATHERWORKS LLC, its corporate parents, subsidiaries and affiliates, if any; and their officers, directors, shareholders, employees, attorneys, agents or other representatives.

C. The term “EVIDENCING” means showing, tending to show, proving, or tending to prove.

D. The term “RELATING” means concerning, relating to, referring to, commenting upon, describing, associated with, comprising or constituting.

E. The term “RESPONDENT’S MARK” means the trademark that is the subject of United States Patent and Trademark Office Reg. No. 3872561.

F. The term “REGISTRATION” means the registration of RESPONDENT’S MARK, Reg. No. 3872561.

G. The term “PETITIONER’S MARKS” means the marks that are the subject of United States Patent and Trademark Office Application Nos. 85/677,529 and 85/677,632 and the trademarks FRANK CLEGG and F. CLEGG as protected under the common law.

H. The “COMPLAINT” refers to the Petition for Cancellation filed by PETITIONER in this proceeding.

I. The “ANSWER” refers to the Answer filed by RESPONDENT in this action.

J. The term “PERSON” is defined as any natural person or any business, legal or governmental entity, or association.

K. The terms “COMMUNICATE” and “COMMUNICATION” mean the transmittal of information (in the form of facts, ideas, inquiries or otherwise).

L. When referring to a document, to “IDENTIFY” means to give, to the extent known, the (i) type of document; (ii) title of the document; (iii) general subject matter; (iv) date of the document; (v) author(s), addressee(s), and recipient(s); and (iv) the production numbers assigned to the document (or, if no production numbers have been assigned, the number of pages in the document).

M. When referring to a PERSON, to “IDENTIFY” means to give, to the extent known, the (i) name of the PERSON; (ii) last known contact information of the PERSON, including without limitations such PERSON’s physical address, place of business, telephone number and email address; and (iii) the title such PERSON holds at any IDENTIFIED place of business.

N. The terms “ALL” and “EACH” shall be construed as all and each.

O. The connectives “AND” and “OR” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside its scope.



P. The use of the singular form of any word includes the plural and vice versa.

Q. The word "DOCUMENT" means all documents and electronically stored information as contemplated by FRCP Rules 26 and 34, including: any written or graphic matter or other means of preserving thought or expression, and all tangible things from which information can be processed or transcribed, whether printed, recorded or reproduced by any other mechanical, electronic or computerized process, or written or produced by hand, including the originals and all non-identical copies, whether different from the original by reason of any notation made on such copy or otherwise, including but not limited to: correspondence, memoranda, notes, logs, messages, letters, e-mail, records, telegrams, teletype, telefax, bulletins, diaries, communications, interoffice and intraoffice telephone call diaries, chronological data, minutes, books, reports, charts, ledgers, invoices, worksheets, computer printouts and computer memory, word processing data, schedules, affidavits, contracts, agreements, patents, licenses, legal pleadings, transcripts, statistics, surveys, magazine or newspaper articles, stories or clippings, graphic or aural records or representations of any kind, including without limitation photographs, charts, graphs, microfiche, microfilm, videotape, recordings, motion pictures and electronic, mechanical or electric recordings or representations of any kind (including, without limitation, tapes, cassettes, discs, and recordings). The term DOCUMENT includes documents containing COMMUNICATIONS. Accordingly, a request for DOCUMENTS includes DOCUMENTS containing relevant COMMUNICATIONS.

R. The term "THIRD-PARTY" shall refer to any person or entity other than RESPONDENT or PETITIONER.

S. The term "DEMOGRAPHICS" as used in reference to consumers or potential consumers means the general characteristics of the consumers to whom the goods are sold or are intended to be sold, including gender, age range, geographic locations, range of annual salary and other such general characteristics if known.

T. The term "MARKETING" means ADVERTISING and PROMOTION.

U. The term "ADVERTISING" means any communication intended to bring goods under a trademark or service mark to the attention of potential and actual consumers and/or to induce their purchase, whether general, direct or interactive in nature, including television and radio commercials, long and short form infomercials, print ads, point of purchase and other in-store displays, banner ads and other web-based ads, ads appearing on search engine results and social media websites such as Google and Facebook ads, and the like.

V. The term "PROMOTION" means activities or events intended to bring goods sold under a trademark or service mark to the attention of potential and actual consumers and/or to induce their purchase, whether general, direct or interactive in nature, including sweepstakes, contests, sponsored events, print or web-based coupons (an example of the latter being GroupOn), events

that involve the use of goods (for example, wine tasting events), and all other activities and events having as their purpose in whole or part to promote goods sold or to be sold under a trademark or service mark.

W. The term "BRAND IDENTITY" means the development of the look and feel and/or persona for a trademark or service mark, including logo development, package design and other activities usually associated with "brand identity."

X. If YOU refuse to produce any DOCUMENT responsive in whole or in part to any Request, YOU must state each specific ground for YOUR refusal. If YOU claim privilege as a ground for not producing any DOCUMENT in whole or in part, describe the factual basis for YOUR claim of privilege in sufficient detail so as to permit the Court to adjudicate the validity of the claim. At a minimum, this must include for each DOCUMENT so withheld: the author(s); the addressee(s) and person(s) copied; the general subject matter of the DOCUMENT; the date of the DOCUMENT; and the specific grounds for withholding the DOCUMENT. If YOU object to producing any part of any DOCUMENT, YOU must produce the portions of the DOCUMENT to which you do not object.

Y. If any portion of a DOCUMENT is responsive to this Request, then the entire DOCUMENT shall be produced. DOCUMENTS produced pursuant to this Request shall be produced in the order in which they appear in YOUR files, and shall not be shuffled or otherwise rearranged. DOCUMENTS that in their original condition were stapled, clipped, or otherwise fastened together shall be produced in such form.

Z. Unless otherwise specified, these requests pertain only to YOUR activities in the United States.

### **REQUESTS FOR PRODUCTION**

Please produce the following DOCUMENTS:

1. DOCUMENTS EVIDENCING RESPONDENT's use in commerce of RESPONDENT'S MARK for each of the goods identified in the REGISTRATION.
2. DOCUMENTS describing each of the goods identified in the REGISTRATION.
3. DOCUMENTS describing each of the goods sold under RESPONDENT'S MARK.
4. All DOCUMENTS RELATING to the clearance of RESPONDENT'S MARK, including all trademark clearance searches and opinions RELATING to such clearance. As used

here, "clearance" means the activities engaged in or on behalf of RESPONDENT RELATING to determining whether RESPONDENT'S MARK was available for use and registration for the goods identified in the REGISTRATION.

5. All DOCUMENTS RELATING to the selection of RESPONDENT'S MARK, including any and all other trademarks and service marks considered by RESPONDENT as alternatives for RESPONDENT'S MARK.

6. All DOCUMENTS RELATING to YOUR claim of ownership in the CLEGG portion of RESPONDENT'S MARK.

7. All DOCUMENTS RELATING to the grounds on which YOUR claim of ownership in the CLEGG portion of RESPONDENT'S MARK are based.

8. For each of the goods offered by RESPONDENT under RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY each distributor and retailer through which it was, has been and is being sold, if any.

9. For each of the goods offered by RESPONDENT under RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY each of the channels of trade through which it was, has been and is being sold, if any.

10. DOCUMENTS identifying the first use in commerce of RESPONDENT'S MARK for each of the goods identified in the REGISTRATION.

11. For each of the goods offered by RESPONDENT under the RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY for each year in which it was sold all of the ADVERTISING for each and the media in which it was advertised.

12. For each of the goods offered by RESPONDENT under RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY for each year in which it was sold all of the PROMOTIONS for each.

13. For each of the goods offered by RESPONDENT under RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY the DEMOGRAPHICS of the consumers of such goods.

14. For each of the goods offered by RESPONDENT under RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY for each year in which such goods were sold the total revenues derived by RESPONDENT from such sales.

15. DOCUMENTS sufficient to IDENTIFY for each of the goods offered by RESPONDENT under RESPONDENT'S MARK, the suggested retail purchase price, if any, and the actual retail purchase price, if known.

16. For each of the goods offered by RESPONDENT under the RESPONDENT'S MARK, DOCUMENTS sufficient to IDENTIFY for each year in which such goods were sold all ADVERTISING and PROMOTIONS.
17. DOCUMENTS sufficient to IDENTIFY all PERSONS who have been in charge of or have had primary responsibility for sales of goods sold under RESPONDENT'S MARK since RESPONDENT'S MARK first was used.
18. DOCUMENTS sufficient to IDENTIFY all PERSONS who have been in charge of or have had primary responsibility for the MARKETING of goods sold under RESPONDENT'S MARK since RESPONDENT'S MARK first was used.
19. DOCUMENTS sufficient to IDENTIFY all PERSONS employed by or under contract with YOU who have sold or will sell goods under RESPONDENT'S MARK.
20. DOCUMENTS sufficient to IDENTIFY all PROMOTION agencies or other THIRD PARTIES YOU use or will use in connection with the PROMOTION or other MARKETING of goods for sale under RESPONDENT'S MARK.
21. DOCUMENTS sufficient to IDENTIFY all ADVERTISING agencies or other THIRD PARTIES YOU use or will use in connection with the ADVERTISING or other MARKETING of goods for sale under RESPONDENT'S MARK.
22. DOCUMENTS sufficient to IDENTIFY all BRAND IDENTITY agencies or other THIRD PARTIES YOU use or will use RELATING to RESPONDENT'S MARK.
23. DOCUMENTS sufficient to IDENTIFY all of YOUR primary contacts at each of the PROMOTION, ADVERTISING and BRAND IDENTITY agencies YOU have used or intend to use in connection with the MARKETING of goods for sale under RESPONDENT'S MARK.
24. All DOCUMENTS RELATING to YOUR enforcement of RESPONDENT'S MARK under the U.S. Trademark Act and/or analogous state trademark or unfair competition laws.
25. All DOCUMENTS EVIDENCING YOUR assertion in YOUR first affirmative defense that "Petitioner has not and will not be damaged by the registration of the trademark LOTUFF & CLEGG and therefore lacks standing to petition to cancel the registration."
26. All DOCUMENTS EVIDENCING YOUR assertion in YOUR second affirmative defense that "Petitioner further lacks standing to petition to cancel the registration because FRANK CLEGG and F. CLEGG, for which the Subject Applications seek registration, are primarily merely a surname which cannot be registered by the U.S. Patent and Trademark Office."

27. All DOCUMENTS EVIDENCING YOUR assertion in YOUR third affirmative defense that "Petitioner is barred from seeking cancellation of Registrant's Mark under the doctrines of laches, estoppel, waiver, and unclean hands."

28. All DOCUMENTS EVIDENCING YOUR assertion in YOUR fourth affirmative defense that "Petitioner has long acquiesced in, participated in, and profited from Registrant's adoption, registration, and use of Registrant's Mark."

29. All DOCUMENTS EVIDENCING YOUR assertion in YOUR fifth affirmative defense that "Petitioner made one or more material omissions to the TTAB by filing the Petition and failing to inform the TTAB that Petitioner has long acquiesced in, participated in, and profited from Registrant's adoption, registration, and use of Registrant's Mark."

30. All DOCUMENTS provided to YOU by each expert, including all written reports contemplated by F.R.C.P 26(a)(2)(b).

31. All DOCUMENTS RELATING to each and every survey, study or poll conducted by or on behalf of YOU in connection with this proceeding.

32. All DOCUMENTS to be offered by YOU at trial (during your Testimony Period) in this proceeding.

33. All DOCUMENTS RELATING to RESPONDENT's policy with respect to retention of documents, including business records.

Dated: August 21, 2013

HOLMES WEINBERG, PC

By /Steven M. Weinberg/  
Steven M. Weinberg

30765 Pacific Coast Highway, Suite 411  
Malibu, California 90265  
Telephone: (310) 457-6100  
Email: smweinberg@holmesweinberg.com

Attorneys for FRANK CLEGG LEATHERWORKS LLC

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **PETITIONER'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS TO RESPONDENT EL GROUP, LLC** has been served on RESPONDENT's counsel by mailing a copy on August 21, 2013, via United States Postal Service Priority Mail, postage prepaid, to:

James C. Duda  
Bulkley, Richardson & Gelinas LLP  
1500 Main Street, Suite 2700  
P.O. Box 15507  
Springfield, MA 01115-5060  
[jduda@bulkley.com](mailto:jduda@bulkley.com)

/Nelda Piper/  
Nelda Piper

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Reg. No. 3872561

Frank Clegg Leatherworks LLC,

Petitioner,

v.

El Group, LLC,

Respondent.

Cancellation No. 92056574

PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSION TO RESPONDENT EL  
GROUP, LLC

PETITIONER FRANK CLEGG LEATHERWORKS LLC ("PETITIONER") propounds the following PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSION TO RESPONDENT EL GROUP, LLC and requests that, pursuant to Rules 26 and 36 of the Federal Rules of Civil Procedure, and Rule 2.120 of the Trademark Rules of Practice (37 C.F.R. §2.1.20), all documents and things responsive to these Requests be produced at the offices of PETITIONER's counsel, Steven M. Weinberg, Holmes Weinberg, PC, 30765 Pacific Coast Highway, Suite 411, Malibu, California 90265, within thirty (30) days from the service hereof.

**DEFINITIONS AND INSTRUCTIONS**

A. "RESPONDENT" and "YOU" shall refer to EL GROUP, LLC, its corporate parents, subsidiaries and affiliates, if any; and their officers, directors, employees, attorneys, agents, and other representatives.

B. "PETITIONER" shall refer to PETITIONER FRANK CLEGG LEATHERWORKS LLC, its corporate parents, subsidiaries and affiliates, if any; and their officers, directors, shareholders, employees, attorneys, agents or other representatives.

C. "FRANK CLEGG" shall refer to the PERSON Francis A. Clegg, PETITIONER's sole member.

D. The term "RESPONDENT'S MARK" means the trademark that is the subject of United States Patent and Trademark Office Reg. No. 3872561.

E. The term "PERSON" is defined as any natural person or any business, legal or governmental entity, or association.

F. The terms "ALL" and "EACH" shall be construed as all and each.

G. The connectives "AND" and "OR" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside its scope.

H. The use of the singular form of any word includes the plural and vice versa.

I. The term "THIRD-PARTY" shall refer to any person or entity other than RESPONDENT or PETITIONER.

J. If YOU cannot truthfully admit or deny a request, YOU must set forth in detail the reason why. If YOU claim "lack of information or knowledge" as the reason for failure to admit or deny, YOU must also state that YOU have made reasonable inquiry and that the information known or readily obtainable is insufficient to enable YOU to admit or deny the request.

K. Unless otherwise specified, these requests pertain only to YOUR activities in the United States.

### **REQUESTS FOR ADMISSION**

Please admit the truth of the following Request:

1. The CLEGG portion of RESPONDENT'S MARK refers to FRANK CLEGG.



Dated: August 21, 2013

HOLMES WEINBERG, PC

By /Steven M. Weinberg/  
Steven M. Weinberg

30765 Pacific Coast Highway, Suite 411  
Malibu, California 90265  
Telephone: (310) 457-6100  
Email: smweinberg@holmesweinberg.com

Attorneys for FRANK CLEGG LEATHERWORKS LLC

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSION TO RESPONDENT EL GROUP, LLC** has been served on RESPONDENT's counsel by mailing a copy on August 21, 2013, via United States Postal Service Priority Mail, postage prepaid, to:

James C. Duda  
Bulkley, Richardson & Gelinas LLP  
1500 Main Street, Suite 2700  
P.O. Box 15507  
Springfield, MA 01115-5060  
[jduda@bulkley.com](mailto:jduda@bulkley.com)

\_\_\_\_\_  
/Nelda Piper/  
Nelda Piper

# EXHIBIT D

## Duda, James

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**From:** Steven M. Weinberg [smweinberg@holmesweinberg.com]  
**Sent:** Wednesday, August 28, 2013 7:12 PM  
**To:** Duda, James  
**Cc:** Nelda Piper; Michael J Salvatore  
**Subject:** Cancellation No. 92056574

Dear Mr. Duda:

We received your client's discovery requests today. The discovery requests were dated August 26<sup>th</sup>. Discovery closed August 24<sup>th</sup>. Accordingly, the requests were untimely served and will not be responded to. We also are of the view that they were served in bad faith given your client's refusal to consent to my client's request for an extension of the discovery period on the ground that you saw "no value" in extending the discovery period.

Regards,

**Steven M. Weinberg**

Holmes Weinberg, PC

30765 Pacific Coast Highway, Ste. 411 | Malibu CA 90265

t: 310.457.6100 x 204 | c. 310.487.7558 | f: 310.457.9555

[smweinberg@holmesweinberg.com](mailto:smweinberg@holmesweinberg.com) | [www.holmesweinberg.com](http://www.holmesweinberg.com)

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